

REMARKS/ARGUMENTS

Claims 34-42, 46-48, and 51-69 are active.

Claims 34, 62 and 63 are amended to define that the units with an LCST are selected from the group consisting of polyethers; polymeric N-substituted acrylamide derivatives containing units with an LCST; and copolymeric N-substituted acrylamide derivatives containing units with an LCST. Support for the amendment is found in previously presented Claim 43 (now cancelled) and the specification as originally filed.

The remaining amendments are for claim dependency and clarity.

As a result, no new matter is added.

The rejection remaining is whether Claims 34-69 are anticipated under 35 U.S.C. 102(b) in view of U.S. 5,730,966 ("Torgerson").

As set forth in the specification on page 2, lines 19-26, the aim of the present invention is to satisfy :

The need for a composition with an optical effect, which gives, after application deposits or films with excellent staying power even under humid and/or hot atmospheric conditions. The said composition that can provide a wide range of textures, in particular at room temperature, allows an easy application.

The heat-induced gelling properties of the polymer included in the claimed cosmetic compositions are due to the units with an LCST as discussed in the specification on page 6, line 1, to page 8, line 2.

Torgerson does specifically describe preparing copolymers (A) with polyethers; polymeric N-substituted acrylamide derivatives containing units with an LCST; and

copolymeric N-substituted acrylamide derivatives containing units with an LCST; AND (B) a block polymer comprising water-soluble blocks alternating with LCST blocks; **OR** a graft polymer whose backbone is formed from water-soluble units and bears LCST grafts (see Claim 34, for example).

One reason that this Torgerson rejection has been maintained is noted in the Examiner's Answer at page 6, lines 10 to 12: "*The N-Vinylpyrrolidones, N-Vinylcaprolactams (column 10, lines 13 to 46) and the monomer/polymer units listed in column 9, line 1 to column 13, line 27 are the B-monomers meeting the limitation of LCST of claims 43 and 44*".

This section relied upon in Torgerson to teach the LCST units but it should be apparent that this section of Torgerson does not teach that which is claimed here--polyethers; polymeric N-substituted acrylamide derivatives containing units with an LCST; and copolymeric N-substituted acrylamide derivatives containing units with an LCST. Therefore, on this basis, the Torgerson disclosure does not provide the requisite disclosure to anticipate the claims.

Further, the composition and its use as defined in the claims would not have been obvious based on what Torgerson describes because the compositions, which have an optical effect, exhibit surprising advantages and effects as discussed on pages 3 to 5 of the specification. Those surprising properties are primarily due to the specific units with an LCST included in the polymers. As stated on page 6, lines 21 to 29: "*These units with an LCST of the polymer used in the composition with an optical effect according to the invention correspond to a specific definition which, fundamentally, makes it possible to give the polymer all the advantageous properties described above relating especially to the suppression of the tack and to the improvement in the staying power and in the transfer-resistance properties of films or deposits obtained from these compositions*".

Furthermore, examples 2 and 3 of the application demonstrated that a mascara composition and a foundation composition according to the invention including polymer 1 of Table 1 (a polymer according to amended claim 34 including units with an LCST as restricted above, namely a random (EO) 6(PO) 39 polymer) exhibit the properties described on pages 3 to 65, the compositions give deposits or films with good staying power under a humid atmosphere. Thus, the specification provides evidence that the specific polymers including specific units with an LCST as now claimed i exhibit unexpected and surprising properties and actually solve the problem the inventors were seeking to address.

Still further, in Example 1, page 37, it is also demonstrated that the tack of polymer 1 according to the invention remains zero irrespective of the relative humidity or the temperature.

Also as has been explained previously, Torgerson does not describe a block polymer as claimed nor provides any direction to the graft polymer which is also an option as claimed. Therefore, on this basis, the rationale for maintaining the rejection was not proper.

When Torgerson describes a graft copolymer, it has an elastomeric, flexible backbone and rigid, thermoplastic, hydrophilic side chains (col. 2, lines 37-56; lines 47 and 48; col. 3, lines 17, 33, and 34; col. 4, lines 54-56 and lines 65-67, and col. 5, lines 52-54). Thus, Torgersons B monomers, which are the grafts or side chains, are hydrophilic in the entire reference (the ethylenically unsaturated moiety E copolymerizable with A is NOT hydrophilic but B as a whole is hydrophilic and in the final copolymer E is part of the backbone). See col. 3, line 17; col. 9, line 1; col. 10, lines 13-17).

There is no disclosure where the A units form water-soluble polymers as alleged by the Examiner. While some of the A monomers in Torgerson may be water-soluble, the

backbone itself, which is a polymer of the A monomers and E moieties (part of the B monomers) as a whole are NOT water-soluble.

One reading the Torgerson disclosure comes away with the necessary teaching to prepare polymers with an elastomeric or flexible backbone and a rigid, thermoplastic, hydrophilic side chains (col. 4, lines 54-56) and are unlike those in the claims which have a water-soluble backbone. Thus, Torgerson's disclosure would teach away from the types of polymers defined in the claims particularly as Torgerson teaches the art to select the A monomers which are not water-soluble (see MPEP § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims). Moreover, going against the explicit requirements of Torgerson's disclosure would effectively render its disclosure meaningless (see MPEP § 2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference)).

The first option in Claim 34, which is defined as a block copolymer with alternating units of water-soluble and LCST blocks, is clearly different than the grafted polymers described by Torgerson. Therefore, even if one could simply pick and choose the appropriate monomers, the monomers would not be arranged as in the present claims following the description in Torgerson.

In response, the Examiner states, in part, "Torgerson meets claim 34 by disclosing a graft polymer" again picking through the Torgerson disclosure for A monomers and B monomers (see page 7 of the Final Official Action mailed October 13, 2006). The point is missed. That is, one reading the entirety of the Torgerson disclosure (as is required), would lead one towards non water-soluble units in the backbone (the A units) because as discussed above, and repeated again: IN TORGERSON'S GRAFTS, THE SIDE CHAINS ARE WATER-SOLUBLE NOT THE BACKBONE UNITS.

Concerning the second option in Claim 34, which is defined as a water-soluble backbone with LCST grafts, this polymer is certainly not described in Torgerson because at col. 5, line 48-62 Torgerson describes:

The copolymers of the present invention are formed from the copolymerization of randomly repeating A and B units . . . In typical embodiments of these copolymers, **the backbone is primarily derived from the ethylenically unsaturated portion of the A monomer unit and the ethylenically unsaturated portion of the B macromonomer unit.** *The side chains are derived from the non-copolymerized portions of the macromonomer.*

Where is there a description for a water-soluble backbone with LCST grafts?
Certainly not here.

Further, Torgerson describes that the water-soluble monomers that impart the polymer with water-solubility, see again col. 4, lines 55-56 of Torgerson: “an elastomeric or flexible backbone and rigid, thermoplastic, hydrophilic side chains.”

In view of the above discussion and the submitted amended claims, it is requested that the rejection based on Torgerson be reconsidered and withdrawn.

As for the provisional rejection under the doctrine of obviousness-type double patenting, Applicants request that the rejection be held in abeyance since the alleged conflicting claims have not yet been patented (see MPEP § 822.01).

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Amendment

After reconsideration of the rejections in view of the above discussion, Applicants request a Notice of Allowance for all pending claims.

Respectfully submitted,

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